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Paper No. 9

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In re Application of :
Horgan et al. :
Application No. 08/908,994 :
Filed: August 8, 1997 :
Attorney Docket No. 36212.00006 (SYN5397.01A) :

OFFICE OF PETITIONS

ON PETITIONS

This decision concerns the October 6, 2003 petition under 37 CFR 1.47(a), and the concurrently filed petition under 37 CFR 1.137(b).

The petition under 37 CFR 1.47(a) is **DISMISSED**.
The petition under 37 CFR 1.137(b) is **DISMISSED**.

The application, upon filing, did not include an oath or declaration. On July 28, 1999, a "Notice to File Missing Parts of Application" was mailed, requesting that an oath or declaration in compliance with 37 CFR 1.63 be filed within an extendable 2-month period.

No response was filed on or before February 28, 2000, and no extension of time under 37 CFR 1.136(a) was obtained. The application became abandoned on September 29, 1999.

Petition under 37 CFR 1.47(a)

The petition, accompanied by a declaration signed by 3 of the 4 inventors named in the application, asserts that the non-signing inventor, Michael Gardner, could not be reached after diligent effort, and requests that the signing inventors be allowed to file the application on behalf of themselves and Michael Gardner.

Under 37 CFR 1.47(a), the available inventors may do so, provided that the petition shows, to the satisfaction of the Commissioner, that a diligent effort was made to locate/reach Michael Gardner, and that, despite such an effort, Michael Gardner could not be located or reached.

The instant petition indicates that on May 30, 2003, counsel for Assignee mailed a copy of the application to Michael Gardner at his last known address in Hong Kong; and that on June 24, 2003, the application papers were returned to counsel as undeliverable. Apparently, none of the available inventors knows of Michael Gardner's new address. The petition, while asserting that an Internet name search for Michael Gardner was unsuccessful, has not supplied any evidence of

the Internet search.¹

In view of the above, the Office is unable to conclude that a reasonably diligent effort was made to locate/reach Michael Gardner. The §1.47(a) petition is thus dismissed.

The Office acknowledges receipt with the petition of the \$130 petition fee and the \$65 surcharge (small entity) for lacking a proper oath or declaration upon filing of the application.

Petition under 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply to the Office action, unless previously filed;² (2) the petition fee; (3) a statement that the **entire** delay in filing the required reply from its due date until the filing of a grantable §1.137(b) petition was unintentional;³ and (4) a terminal disclaimer for a utility application filed before June 8, 1995.⁴

The petition encloses the \$665 petition fee (small entity). However, with the dismissal of the §1.47(a) petition, the declaration submitted with the petition is not accepted, and the §1.137(b) petition is dismissed for not meeting the threshold requirement of item (1) above.

A renewed §1.137(b) petition (no petition fee) must be filed within **TWO MONTHS** of the mailing date of this decision,⁵ and be accompanied by either:

- (1) an oath/declaration properly signed by all inventors, including Michael Gardner;⁶
or
(2) a renewed §1.47(a) petition (no petition fee) that includes sufficient showing, as discussed above, that a reasonably diligent effort was made, in vain, to locate or

¹ The last known address for Michael Gardner indicated in the petition appears to be an office address. Since Michael Gardner is a U.S. citizen, and if he can no longer be located in the Hong Kong work address, it may be prudent to conduct a name search in the U.S. database through, e.g., Lexis.com. The petition fails to point out in which database the name search was conducted.

² In the instant case, the “required reply” to the 7/28/99 Notice to File Missing Parts is an oath/declaration in compliance with 37 CFR 1.63, such as one accepted under a granted §1.47 petition.

³ The application has been abandoned for more than 4 years. Such a statement is a prerequisite to reviving the application. However, the statement is inappropriate even if only part of the entire delay in filing a proper oath/declaration was intentional, and may adversely affect enforcement of any patent resulting from the application. MPEP 711.03(c)(III)(C) (Rev. 1, Feb. 2003).

⁴ Inapplicable to this application.

⁵ Extensions of time may be obtained under 37 CFR 1.136(a).

⁶ A supplemental declaration listing the invention and/or the application number, the entire inventorship; and is signed only by Michael Gardner, is sufficient.

reach Michael Gardner.⁷

The renewed §1.137(b) petition under either of the options should be addressed as follows:

by fax:⁸ (703) 308-6916
Attn: Office of Petitions

Finally, the application, upon filing on August 8, 1997, enclosed a basic filing fee in the amount of \$385 (small entity) without a specific assertion of entitlement to small entity status. Under 37 CFR 1.27(c)(3), such a payment of the exact amount of the small entity basic filing fee should have been treated as a written assertion of entitlement to small entity status. However, the Office of Initial Patent Examination erroneously charged an additional \$385, and a \$130 surcharge,⁹ to Deposit Account No. 05-0150, which is the account of the prior counsel's firm.¹⁰ The overcharge (\$385 and \$130, totaling \$515) has been credited to Deposit Account No. 05-0150.¹¹

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

⁷ The steps taken to locate the whereabouts of Michael Gardner should be included in a statement of facts, signed by the person with firsthand knowledge of the facts recited therein. MPEP section 409.03(d) INVENTOR CANNOT BE REACHED (Rev. 1, Feb. 2003).

⁸ This facsimile number may not be used after 12/1/03 for filing petitions.

⁹ A surcharge was assessed for late filing of the entire basic filing fee, based on the misunderstanding that Assignee was not entitled to small entity status. The amounts of the fees submitted with the instant petition indicate that Assignee is entitled to small entity status.

¹⁰ Graham & James LLP, 600 Hansen Way, Palo Alto, CA 94304 (Docket No. 36212.00006).

¹¹ Counsel should coordinate with Graham & James re whether the 2 fees were already charged to Assignee. If so, Assignee should be re-imbursed by Graham & James. If, on the other hand, Assignee is not entitled to small entity status, any fee deficiency associated with the instant petition must be submitted upon receipt of the decision.